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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,511	03/18/2004	Vinod K. Parasher	PARASHER-1	5419
7590	08/25/2005		EXAMINER	
Connolly Bove Lodge & Hutz LLP P.O. Box 2207 Wilmington, DE 19899-2207			KASZTEJNA, MATTHEW JOHN	
			ART UNIT	PAPER NUMBER
			3739	
DATE MAILED: 08/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/803,511	PARASHER ET AL.
	Examiner	Art Unit
	Matthew J. Kasztejna	3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 06 June 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-11, 13-15 and 18 is/are rejected.  
 7) Claim(s) 12, 16, 17, 19 and 20 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 18 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>6/6/05</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

**DETAILED ACTION**

***Notice of Amendment***

In response to the amendment filed on June 6, 2005, amended claims 1 and 4-5; canceled claim 20 and new claims 7-20 are acknowledged. Claims 1-3 stand rejected under 35 USC § 102. The following new and reiterated grounds of rejection are set forth:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S Patent No. 6,764,439 to Schaaf et al.

**In regards to claim 1,** Schaaf et al. disclose a probe vibrating assembly 30 for endoscopic procedures comprising a main body, a spindle 70 in the main body, a drive mechanism 60 for rotating the spindle, a drive member 66 eccentrically mounted to the spindle, a clamp mechanism 75, the eccentrically mounted drive member being secured to the clamp mechanism for moving the clamp mechanism back and forth in accordance with the movement of the eccentric drive member, cylinder 34 clamped in the clamp mechanism, the clamp mechanism thereby causing the cylinder to move back and forth

in response to the movement of the clamp mechanism, a probe extending through the cylinder and mounted for joint back and forth movement with the cylinder, a medical scope 25, the probe mounted to the medical scope, and the probe extending outwardly beyond the medical scope (see Figs. 1 and 6a).

**In regards to claim 2**, Schaaf et al. disclose a probe vibrating assembly 1 wherein the probe is a guide wire (see Col. 9, Lines 65-67).

**In regards to claim 3**, Schaaf et al. disclose a probe vibrating assembly including a catheter 34 mounted to the medical scope and extending through the medical scope, and the guide wire 35 being disposed in the catheter (see Col. 9, Lines 59-64).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4-11, 13-15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S Patent No. 6,764,439 to Schaaf et al. in view of U.S. Patent No. 4,735,604 to Watmough et al.

**In regards to claim 4**, Schaaf et al. disclose a probe vibrating assembly wherein the probe is a flexible needle terminating in a knife edge (see Fig 3a) but is silent with respect to the knife edge breaking up a tumor tissue to facilitate the tissue being removed. Watmough et al. teach of an analogous apparatus used for removing

biological material from the body. The device includes an aspirating means for removing living tissue from the body (see Col. 4, Lines 3-6).

**In regards to claims 5-7 and 15**, Schaaf et al. disclose a probe vibrating assembly including a cylinder clamped by the clamp mechanism, a plunger telescopically mounted in the cylinder, and the needle extending through the cylinder and the plunger. Schaaf et al. teach of two embodiments shown in Figs. 4G-H wherein a hollow cylindrical needle head piece 80 and 81 through which tissue particles can be surgically suctioned off be means not shown (see Col. 8, Lines 9-14). It is well known in the art to use aspiration structures, (see Col. 4, Lines 44-46), to help with tissue biopsy, comprising a plunger and cylinder through which the tissue is extracted. Furthermore, Watmough et al. teach of an analogous device used to remove living tissue from a body. The surgical aspirator 2 is provided with an aspiration system to remove tissue fragments, liquids and other material from the region of the tissue being operated upon. It would have been obvious to one skilled in the art at the time the invention was made to include an aspirator system in the apparatus of Schaaf et al. to allow for the removal of tissue during operation, thus keeping the area clear of debris as taught by Watmough et al

**In regards to claim 8**, Schaaf et al. disclose a probe vibrating assembly wherein the spindle is driven by a variable speed control, as the motor can inherently be turned off and on.

**In regards to claim 9**, Schaaf et al. disclose a probe vibrating assembly wherein the variable speed control is foot operated (see Col. 4, Line 30).

**In regards to claim 10**, Schaaf et al. disclose a probe vibrating assembly wherein the variable speed control is manually operated (see Col. 5, Line 30)

**In regards to claims 11 and 18**, Watmough et al. disclose a probe vibrating assembly wherein the spindle is rotatable about its longitudinal axis, the drive member being part of an oscillating head, the eccentrically mounted drive member moving in an eccentric path with the longitudinal axis of the drive member being spaced from the longitudinal axis of the spindle, and the drive member being mounted in an elongated slot in a slide plate in the oscillating head to move the slide plate in a back and forth direction perpendicular to the longitudinal axis of the spindle (see Col. 4, Lines 7-50).

**In regards to claims 13-14**, Watmough et al. disclose a probe vibrating assembly wherein the back and forth movement is in a direction perpendicular to the longitudinal axis of the spindle (see Col. 4, Lines 7-25). Furthermore the medical scope 36 is detachably mounted to the main body.

#### ***Allowable Subject Matter***

Claims 12, 16-17 and 19-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

Applicant's arguments filed June 6, 2005 have been fully considered but they are not persuasive.

Applicant states that "it is clear that the coupling 75 is mounted directly to the tool and is not clamped to any cylinder, nor is there any suggestion in Schaaf for having

back and forth movement of a cylinder and probe". Furthermore, applicant states the in the device of Schaaf the tool slides within guide 34 which in turn is mounted in channel 33. However, Schaaf discloses that the guide tube 34 is movable in the same direction as the surgical tool 35 (see Col. 5, Lines 20-31 and Fig. 3a). Therefore, it is assumed that the tool 35 and cylinder 34 can have a joint back and forth movement.

Applicant's arguments with respect to claims 4-6 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S Patent No. 3,642,002 to Otterstrom

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJK MK

8/19/05

A. Farah

Primary Examiner

AU: 3739

Matthew J. Kasztejna